



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/916,919

07/27/2001

Shu Lin

PU 010161

8797

24498

7590

05/17/2006

THOMSON LICENSING INC.
PATENT OPERATIONS
PO BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,919

Applicant(s)

LIN, SHU

Examiner

Vincent F. Boccio

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment of 3/3/06.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-17, 19 and 20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 6-17, 19 and 20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 2621

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2621.

Response to Arguments

1. Applicant's arguments filed 3/3/06 have been fully considered but they are not persuasive.

{A} In re pages 7-10 applicant states that as amended, Tanaka does not anticipate the claims 1- as amended.

In response as amended Tanaka does not now anticipate, such as claim 1 as amended, in view of canceling dependent claim 5, rolled into claim 1, now presented as a 103 rejection with Sato.

Also 103 for claim 12, in view of canceling dependent claim 18, rolled into claim 12, now presented as a 103 rejection with Sato, as set forth many actions previously.

{B} In re page 14, applicant states, "there is absolutely no motivation to combine the references Tanaka & Sato" and suggests that the examiner had committed to HINDSIGHT.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Art Unit: 2621

In this case, Sato provides motivation wherein at col. 2, states, "incoming ... stream which is possible at varying rate and/or bursty", this passage describes that the input may be bursty or varying data rate and converting by adding null packets to create a stream that is fixed rate.

{C} In re page 14, applicant states, "the invention of Sato for an MPEG information signal conversion system does not expressly or implied motivate or suggest a combination as required ... references teach different inventions and solutions for absolutely unrelated deficiencies."

In addition to col. 3, "The invention is not limited to application to an MPEG information signal", therefore the statement made above is not persuasive.

The issues with respect to Sato, is not only related to an MPEG signal, col. 3.

The issues with respect to Sato is to add null packets for the purpose of handling an input being variable, wherein the DVCR (DIGITAL VIDEO CASSETTE RECORDER), col. 5, adding Null packets to create a fixed rate and constant, "data rate", thereby, col. 10, "a DVCR can reconstruct at playback, without loss of information, a transport stream that has the rate and timing exactly as schedule by the remux at recording."

In view of Fig. 6, an input that is bursty or varying is modified to add null packets to transform the input having a varying rate, to a KNOWN TRANSPORT stream being, a RATE FIXED & CONSTANT, data Rate signal, to record to the DVCR.

Therefore it is deemed that upon the condition that a varying data rate signal is provided or created, null packets can be added to convert an input rate signal being variable or bursty to a fixed rate signal in order to record and playback to and from the DVCR.

The examiner has reviewed all arguments, most are directed to the combination with Sato, the examiner with respect to the arguments presented fails to find any arguments against Tanaka and Sato any other combination, that are deemed persuasive.

Art Unit: 2621

The primary examiner invites applicant to discuss an amendment (571-272-7373) with respect to the prior art against the applicant's specification, to amend the existing claims to be distinguishable, at least with respect to Tanaka.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4, 6-17, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 12 have been amended to language not existing the originally filed application, such as,

"improve encoding efficiency", is not supported in the specification.

The specification recites, "a dummy program signal can be added to any suitable number of sampled video signals for purpose of improving video encoder performance".

Art Unit: 2621

At this point the specification fails to possess the newly recited claim language of, "improve encoding efficiency", which is not deemed to be the same as, "improving video encoder performance".

The examiner will only accept the limitations as recited by the specification, the examiner does not deem the language added to the claims as being the same, but is different in scope and is therefore, deemed to be new matter.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2621

2. Claims 1-3, 6-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 5,764,847) in view of Sato et al. (US 5,566,174).

Regarding claims 1, 12, has been amended wherein the combination with Tanaka, fails to disclose,

O providing a dummy input to be combined with at least one of the inputs.

Sato teaches, when recording to a tape recording medium, wherein an input having an unknown rate can be varying and/or bursty (Fig. 6), providing a means to input dummy data met by NULL Packet generator 49, thereby to process the video to a known rate fixed & constant in order to record to the DVCR, col. 5 etc..., as taught by Sato.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination by incorporating a null packet generator to modify the video when and if the data rate varies, to create a fixed rate data stream, in order to record to tape of the DVCR, as taught by Sato.

The examiner incorporates by reference the action against claims 2-3, 6-11, 13-17, 19-20.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tanaka (US 5,764,847) and Sato et al. (US 5,566,174) and further in view of Campbell et al. (US 4,967,271).

Regarding claim 4, the combination with Tanaka and Sato fail to disclose up-converting at least one of the sampled multimedia inputs.

Campbell teaches up-converting of a video input, by line doubling the input video signal, having advantages of reducing the visibility of the scan line structure of the picture image, col. 1, doubling from an input video having 262.5 lines per field to 525, in accord to col. 3, eliminate the double imaging artifact ... which occurs in the prior art, as taught by Campbell.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination by incorporating the step of performing line doubling, as taught by Campbell, having advantages as stated above, in view of Campbell.

Art Unit: 2621

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Fax Information


Any response to this action should be faxed to:

(571) 273-8300, for communication as intended for entry,
this Central Fax Number as of 7/15/05

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
5/12/06


VINCENT BOCCIO
PRIMARY EXAMINER